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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,242	03/06/2002	Benjamin Gebhart	24876-A	8044

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EXAMINER

FORD, JOHN K

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 06/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/087242

Applicant(s)

Gebhart

Examiner

FORD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 3-21-03
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2, 5, 8, 10-33 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 17-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 5, 8, 12-16 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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Applicant's election of method claims 2, 5, 8, 10-16 and 37, with traverse, is acknowledged. Applicant's traverse based on the Examiner's not providing supporting reasons for a "serious burden" is unpersuasive because it is an erroneous statement. The Examiner did provide reasons consistent with the guidelines in the MPEP.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5, 8, 10-16 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeber in view of Chu and vice versa and the Marto and Lepere article and (optionally) the 1987 Hesketh dissertation.

This rejection is set forth in the Examiner's Answer, Paper No. 29 of SN 08/485,161, pages 5-15, and it is incorporated here by reference. A courtesy copy of that Examiner's Answer is attached to this office action as and appendix (Appendix A).

A copy of the Board's decision (Appendix B) and the appealed claims (Appendix C) from SN 08/485,161 are also attached here. Both of those documents are also incorporated by reference here.

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It is submitted that the Board may have erred in a factual manner in assuming the values found in Table 1 (specification, page 20) with respect to Marto and Lepere prior art correctly portrayed the performance of the "Aging C" and "Aging D" examples. See paragraph bridging pages 8 and 9 of the Board decision. The Board essentially ignored the fact that the Examiner was challenging the values in Table 1 of applicant's specification pertaining to Marto and Lepere as inaccurate with respect to the "Aging C" or "Aging D" surfaces shown in Figure 11 of Marto and Lepere. The reasons that the Examiner believes applicant's values are deemed inaccurate are set forth in the Examiner's Answer (in a particularly detailed discussion on pages 9-15) attached here. It is believed that the Board has made an error of fact their analysis, a problem with the Board decision that the Examiner found when taking up this application for examination.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 5, 8, 10-16 and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S.

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Patent No. 6,371,199. Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims (2, 5, 8 .... etc) merely recite the invention more broadly than the corresponding claims in USP '199. The rationale for requiring a terminal disclaimer in this case is set forth in In re Goodman, supra. The Goodman case is incorporated here by reference.

The Examiner is requiring applicant to keep a clear line of distinction between the claims here and those found in USP '199, to avoid a statutory double patenting rejection based on the claims of USP 6,371,199. Currently, many of the dependent claims, here, when read to include the limitations of the base claims and any intermediate claims appear to be substantially identical to claims found in USP 6,371,199.